REMARKS

Reconsideration of this application is respectfully requested.

Claims 1, 4-10, 13, 14, 16, 19-22 and 24-26 are pending in the application.

Claims 1, 4, 5, 7-10, 13, 14, 16, 19 and 24-26 stand rejected under 35 U.S.C. §102(b) as being anticipated by Microsoft Project for Windows, hereafter MS-Project.

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over MS-Project in view of alleged knowledge in the art.

Claims 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over MS-Project in view of Wide Workflow Development, hereafter Workflow.

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over MS-Project in view of MS-Project and U.S. patent no. 5,835,898 of Borg ("Borg").

CLAIM REJECTIONS

Rejections under 35 U.S.C. §102(b)

The Examiner has rejected claims 1, 4, 5, 7-10, 13, 14, 16, 19 and 24-26 under 35 U.S.C. §102(b) as being anticipated by MS-Project. Applicants submit that amended claims 1, 4, 5, 7-10, 13, 14, 16, 19 and 24-26 are not anticipated by MS-Project. In regard to the rejection of claim 1, the Examiner has stated in part that:

> "MS-Project discloses on p. 288-289...A method of displaying information relating to a workflow comprising the steps of: overlaying the execution statistics over the workflow diagram, wherein the overlayed information indicates workflow statistics for various steps displayed in the workflow diagram (items E-I)."
>
> (5/16/03, Office Action, pp. 2-3)

Applicants respectfully submit that amended claim 1 is not anticipated by MS-Project. Amended claim 1 recites the feature of "calculating execution statistics relating to the execution of the workflow on the computer system...." (emphasis added). MS-Project does not disclose this feature as stated in applicants' claim 1. MS-Project does not calculate execution statistics as can be seen by the following analysis of MS-Project. MS-Project allows for the entering of project tasks, durations, organizing tasks into a hierarchical structure and links tasks for different kinds of relationships. (MS-Project, p. 207). One feature of MS-Project is a PERT chart which graphically shows not only project schedules, but task dependencies. The tasks are displayed as nodes, where each node contains fields with "information" about the task it represents. (MS-Project p. 288). The task information includes Task ID number, Scheduled start date, Gridline between fields, Scheduled finish date, and duration. (MS-Project p. 289). This task information is not *execution statistics* as claimed by applicants' claim 1. Nor does MS-Project disclose applicants' feature of "calculating execution statistics relating to the execution of the workflow...." (Claim 1).

Because MS-Project does not disclose this feature as taught by claim 1, from which claims 4-8 depend, applicants respectfully submit that claims 1 and 4-8 are not anticipated under 35 U.S.C. §102(b) by MS-Project.

The Examiner also rejected independent claim 9 under 35 U.S.C. §102(b) for the reason set forth in the rejection of claim 1. Claim 9 discloses substantially similar limitations as claim 1, and recites "providing calculated execution statistics relating to an executing workflow..." (Emphasis added) Because, MS-Project does not disclose this feature as taught by applicants' claim 9 from which claim 10 depends, for the reasons discussed above with regard to claim 1, applicants respectfully submit that claims 9-10 are not anticipated under 35 U.S.C. §102(b) by MS-Project.

The Examiner also rejected independent claim 13 under 35 U.S.C. §102(b) for the reason set forth in the rejection of claim 1. Claim 13 discloses substantially similar limitations as claim 1,

and recites "calculating execution statistics relating to the execution of the workflow...." (Emphasis added) Because, MS-Project does not disclose this feature as taught by applicants, claim 13 from which claims 14, 16, and 19-22 depend, for the reasons discussed above with regard to claim 1, applicants respectfully submit that claims 13-14, 16, and 19-22 are not anticipated under 35 U.S.C. §102(b) by MS-Project.

The Examiner also rejected claim 24 under 35 U.S.C. §102(b) as being anticipated by MS-Project. Applicants submit that amended claim 24 is not anticipated by MS-Project. In regard to the rejection of claim 24, the Examiner has stated in part that:

> wherein the overlaid execution statistics indicates the number of times a certain step was executed is disclosed by a task ID number for multiple identical tasks with different start and stop times.
>
> (5/16/03, Office Action, p. 3)

Applicants respectfully disagree with the Examiner. The task ID number of MS-Project associates a number with a task or node in the PERT chart. Even if for repeated workflow tasks, MS-Project's task ID number would be the same and indicate multiple identical tasks with different start and stop times, such behavior is not an overlaid execution statistic which indicates the number of times a certain step was executed. (claim 24) (emphasis added)

Additionally applicants respectfully submit that amended claim 24 is not anticipated by MS-Project, because claim 24 recites the feature of "calculating execution statistics relating to the execution of the workflow on the computer system...." (Emphasis added) MS-Project does not disclose this feature for the reasons discussed above in regard to claim 1. MS-Project does not contemplate "execution statistics relating to the execution of the workflow on the computer system."

Because MS-Project does not disclose these features as taught by claim 24, applicants respectfully submit that claim 24 is not anticipated under 35 U.S.C. §102(b) by MS-Project.

The Examiner has also rejected claim 25 under 35 U.S.C. §102(b) as being anticipated by MS-Project. Applicants submit that amended claim 25 is not anticipated by MS-Project. In regard to the rejection of claim 25, the Examiner has stated in part that:

> wherein the collected execution statistics includes execution time of one or more steps is depicted by "duration" that can be measured in minutes, hours and weeks..."
>
> (5/16/03, Office Action, p. 4)

Applicants respectfully disagrees with the Examiner. The duration value described in MS-Project is based upon the scheduled start (F) and scheduled finish (H). (MS-Project, p. 289). The Duration field described on p. 137 is not the same Duration shown on the PERT chart of p. 289. But instead the Duration field described on p. 137 is for the resource form on pages 87 and 88 which is not a workflow diagram as claimed by applicants.

Additionally applicants respectfully submit that amended claim 25 is not anticipated by MS-Project because claim 25 recites the feature of "calculating execution statistics relating to the execution of the workflow on the computer system...." (Emphasis added). MS-Project does not disclose this feature for the reasons discussed above in regard to claim 1. MS-Project does not contemplate "execution statistics relating to the execution of the workflow on the computer system." Because MS-Project does not disclose this feature as taught by claim 25, applicants respectfully submit that claim 25 is not anticipated under 35 U.S.C. §102(b) by MS-Project.

The Examiner has rejected claim 26 under 35 U.S.C. §102(b), stating that claim 26 is disclosed supra for claims 13 and 20. However, the Examiner does not present any rejection of claim 20 in view of MS-Project. Claim 26 discloses substantially similar limitations as claim 1, and recites calculating execution statistics.... (Emphasis added). Because MS-Project does not disclose this feature as taught by applicants' claim 26 for the reasons discussed above with regard to claim 1, applicants respectfully submit that claim 26 is not anticipated under 35 U.S.C. §102(b) by MS-Project.

Rejections Under 35 U.S.C. §103

The Examiner has rejected claim 6 under 35 U.S.C. §103(a) as being unpatentable over MS-Project in view of MS-Project 2 and the alleged knowledge in the art.

In regard to the rejection of claim 6 under 35 U.S.C. §103(a), the Examiner has stated in part that:

> Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a paused pointer over toolbar buttons as disclosed by MS-Project 2 in combination with a paused mouse pointer over PERT chart statistical information disclosed by Official Notice....
>
> (5/16/03, Office Action, p. 5).

Even if MS-Project, MS-Project 2 and the alleged knowledge were combined, such a combination would lack one or more features of claim 1, from which claim 6 depends. Amended claim 1 recites the feature of "calculating execution statistics relating to the execution of the workflow on the computer system...." (emphasis added). Neither MS-Project nor MS-Project 2 disclose this feature as stated in applicants' claim 1. MS-Project does not calculate execution statistics as can be seen by the following analysis of MS-Project. MS-Project allows for the entering of project tasks, durations, organizing tasks into a hierarchical structure and links tasks for different kinds of relationships. (MS-Project, p. 207). One feature of MS-Project is a PERT chart which graphically shows not only project schedules, but task dependencies. The tasks are displayed as nodes, where each node contains fields with "information" about the task it represents. (MS-Project p. 288). The task information includes Task ID number, Scheduled start date, Gridline between fields, Scheduled finish date, and duration. (MS-Project p. 289). This task information is not *execution statistics* as claimed by applicants' claim 1. Nor does MS-Project disclose applicants' feature of "calculating execution statistics relating to the execution of the workflow...." (Claim 1) (Emphasis added). For the same reasons MS-Project 2 does not disclose this feature.

Thus, because neither, MS-Project, MS-Project 2 nor the alleged knowledge in the art disclose applicants' claim 1, applicants respectfully submit that claim 1, and claims 4-8 which depend from claim 1 are not obvious under 35 U.S.C. §103(a) by MS-Project, in view of MS-Project 2 and in further view of the alleged knowledge in the art.

Claims 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over MS-Project in view of Wide Workflow Development, hereafter Workflow. In regard to the rejection of claims 20-21 under 35 U.S.C. §103(a), the Examiner has stated in part that:

> "It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply mapping workflow diagrams as disclosed by MS-Project in combination with mapping multiple exceptions as disclosed by Workflow."
>
> (5/16/03, Office Action, pp. 5-6)

Applicants respectfully disagree with the Examiner. It is respectfully submitted that it would be impermissible hindsight, based on applicants' own disclosure, to combine MS-Project and Workflow. MS-Project allows for the entering of project tasks, durations, organizing tasks into a hierarchical structure and links tasks for different kinds of relationships. (MS-Project, p. 207). One feature of MS-Project is a PERT chart which graphically shows not only project schedules, but task dependencies. Workflow describes how to identify business transactions based on workflow object life cycles. (Workflow, 4.4.2.3). Workflow does not concern itself with PERT charts nor does Workflow discuss any type of graphical rendering of workflow as done by MS-Project.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

However, nowhere is there any indication that the references provide any motivation for the recited combination. Instead, it appears the teachings of the present application have been used as a

blueprint to gather together and assemble various components of the prior art in the manner contemplated by applicants. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such applications of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (Emphasis added). Merely indicating, as the Examiner argues in his Office Action of November 1, 2002, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet,* at 1357. Instead, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Rouffet,* at 1357.

In the present case, there has been no showing of such motivation. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components, states where each such component may be found in one of the cited references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a determination of obviousness of the present application. The burden is on the Examiner to show *why* one is so motivated as to come up with the combination being relied upon. *Rouffet,* at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the

obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.")

Applicants submit that claims 20-21 are not obvious in view of MS-Project and Workflow. Even if these two references were combined, such combination would not disclose applicants' claim 13 from which claims 20-21 depend. Amended claim 13 recites the feature of "calculating execution statistics relating to the execution of the workflow on the computer system...." (emphasis added).

Neither MS-Project nor Workflow disclose this feature as stated in applicants' claim 1. MS-Project does not calculate execution statistics as can be seen by the following analysis of MS-Project. MS-Project allows for the entering of project tasks, durations, organizing tasks into a hierarchical structure and links tasks for different kinds of relationships. (MS-Project, p. 207). One feature of MS-Project is a PERT chart which graphically shows not only project schedules, but task dependencies. The tasks are displayed as nodes, where each node contains fields with "information" about the task it represents. (MS-Project p. 288). The task information includes Task ID number, Scheduled start date, Gridline between fields, Scheduled finish date, and duration. (MS-Project p. 289). This task information is not *execution statistics* as claimed by applicants' claim 1. Nor does MS-Project disclose applicants' feature of "calculating execution statistics relating to the execution of the workflow...." (Claim 1) (Emphasis added).

Workflow discusses how to identify business transactions based on a workflow object life cycles. (Workflow, 4.4.2.3). The foundation for this type of business transaction identification, lies in creating states, and transitioning between states. Within these transitions, exceptions may occur that require special handling. Workflow describes how to handle such exceptions and return to a normal state. However, nowhere does Workflow disclose applicants' feature of "calculating execution statistics relating to the execution of the workflow...." (Claim 1) (Emphasis added)

Thus, because neither, MS-Project nor Workflow disclose applicants' claim 13, applicants respectfully submit that claim 13, and claims 14, 16, and 19-22 which depend from claim 13 are not obvious under 35 U.S.C. §103(a) by MS-Project, in view of Workflow.

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over MS-Project in view of InfoNet and U.S. patent no. 5,835,898 of Borg ("Borg"). In regard to the rejection of claim 22 under 35 U.S.C. §103(a), the Examiner has stated in part that:

> "Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply workflow process execution disclosed by MS-Project and InfoNet in combination with "workflow percentage" disclosed by Borg....
>
> (5/16/03, Office Action, p. 7).

Applicants submit that claim 22 is not obvious in view of MS-Project, InfoNet and Borg. For the reasons stated above, it would be impermissible hindsight to combine MS-Project, InfoNet and Borg. Even if MS-Project, InfoNet and Borg were combined, such a combination would lack one or more features of independent claim 13 from which claim 22 depends. Amended claim 13 recites the feature of calculating execution statistics relating to the execution of the workflow on the computer system. (emphasis added).

As discussed above, MS-Project does not disclose this feature as disclosed in applicants' claim 13. Nor does InfoNet disclose "calculating execution statistics relating to the execution of the workflow on the computer system" as claimed by applicants. InfoNet does not disclose this feature as can be seen by the following analysis of InfoNet. "InfoNet is custom software developed by DXP to gather necessary information and to keep everyone, both internally and externally, aware of every project detail." The necessary information includes "latest company news, messages from coworkers, clients and task information." Info Net does not contemplate "calculating execution statistics relating to the execution of the workflow on the computer system."

Nor does Borg disclose "calculating execution statistics relating to the execution of the workflow on the computer system" as claimed by applicants. Borg describes a visual schedule management system for a manufacturing facility. (Borg, title). More specifically, Borg describes a computer-based visual schedule management system that provides visual representations of the amount of work scheduled in a manufacturing facility... (Borg, abstract). Nowhere does Borg teach the use of "execution statistics" since it is not needed for its system, and therefore, Borg does not teach "calculating execution statistics relating to the execution of the workflow on the computer system."

Thus, because neither, MS-Project, InfoNet nor Borg disclose applicants' claim 13, applicants respectfully submit that claim 13 and dependent claims 14, 16, and 19- 22 are not obvious under 35 U.S.C. §103(a) by MS-Project, InfoNet and Borg.

Reconsideration of this application, as amended, is respectfully requested. The following remarks are responsive to the Office Action mailed May 16, 2003.

If there are any additional charges, please charge Deposit Account No. 02-2666.

Respectfully submitted,

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